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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/993,767

11/27/2001

Ming-Sum Fang

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EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

09/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/993,767

Applicant(s)

FANG ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,7,8,10,11,13-17,20-23,25-27,29,30,32,33,35-39 and 42-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39, and 42-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Status of Claims***

1. Claims 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39, and 42-69 have been examined.

***Response to Amendments/Arguments***

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39, and 42-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al., U.S. Patent No. 6,877,093 in view of Valliani et al., U.S. Patent No. 6,234,389 and Lynch et al., U.S. Patent No. 6,963,908.

As per claims 1, 3-5, 7, 8, 10, 11, 13-17, 20-23, 25-27, 29, 30, 32, 33, 35-39, and 42-69, Desai et al. teach a method and system for downloading an application to a card terminal (figure 4) comprising:

- receiving a request from a remote network connection a request to download an application to a card terminal using a processing arrangement (figure 6; column/line 10/3-11/32; column 13, lines 5-10 and 30-40)
- using the processing arrangement (figure 6; column/line 10/3-11/32) monitoring a card terminal (column 13, lines 30-34) to detect at least one activity (e.g. process a transaction or close a batch) performed at the card terminal and detecting the monitored activity downloading, by generating and transmitting a data stream over TCP/IP, the application to the card terminal wherein the terminal is reconfigured based on the application (figure 4; column 3, lines 4-11; column/line 6/66-7/24; column 10, lines 15-33; column/line 12/56-13/30; column 13, lines 30-34 and 38-66; column 14, lines 5-8)
- downloading an application to provide an indication of information to be printed on a receipt, audio information to be generated at card

terminal or visual information to be displayed (column 3, lines 4-11;  
column 7, lines 24-37; column 8, lines 23-46; column 13, lines 6-29)

- transmitting a message to the card terminal relating to the triggering of the downloading of configuration data (column 9, lines 41-46; column/line 12/56-13/30)
- a processing arrangement comprising storage containing data related to card terminal configuration (figure 6; column/line 10/3-11/32; column/line 12/56-13/30)
- monitoring the terminal based on the request to re-configure the terminal (column 13, lines 30-34)

Desai et al. teach a user at a card terminal communicating with a web server over the Internet (e.g. dial-up, high-speed, etc.) (column/line 5/60-6/8; column 9, lines 42-46; column 10, lines 2-15) wherein the user and the server interact using a website (figure 8; column 12, lines 56-65) or GUI (column 9, lines 41-46).

Desai et al. do not teach detecting at least one activity such as a financial transaction at a card terminal and in response to the detection downloading an application to the terminal. Lynch et al. teach detecting a financial transaction (e.g. use of a credit card) at a terminal (e.g. PC, laptop, pda) (column 1, lines 18-27; column 9, lines 33-38; column 21, lines 15-20 and 27-38) and in response to the detecting of the transaction downloading a computer application to a terminal (column 9, lines 40-50). Lynch et al. also teach receiving from a remote network

connection a request to download an application to a terminal using a processing arrangement (column 9, lines 12-30). However, Lynch et al. do not apply their system to card terminals. Valliani et al. teach a method and system for converting a terminal, such as a laptop or pda, into a point-of-sale terminal that includes a card reader (abstract). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Desai et al., Lynch et al. and Valliani et al. in order to allow a small business owner, such as a flea market vendor, to convert a laptop or pda to point-of-sale terminal ('389, abstract) and download associated software ('093, column/line 14/57-15/8; '389, column 2, lines 51-55; '908, column 4, lines 45-52) to facilitate card purchases without the need for a large dedicated e-commerce infrastructure ('389, column 2, lines 8-37; '093, column 15, lines 47-58).

As per claims 5, 37 and 38, claims 5 and 37 recite "transmitting the information *upon* detecting a command..." (emphasis added). However, according to the MPEP (MPEP §2106 II C), language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (see also *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); *In re Collier*, 158 USPQ 266 (CCPA 1968); *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006)). Therefore, how Applicant's claimed method, for example, performs if a command is detected cannot differentiate the claims from the prior art.

As per claims 13 and 22, the type of information transmitted does not distinguish the claims from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01).

As per claim 21, claim 16 and 21, merely recite generating information "for display". Hence, as the configuration server of Desai et al. can format information for display (column/line 12/56-13/20) it continues to at least obviate Applicant's claimed method (MPEP 2114; *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

### **Conclusion**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

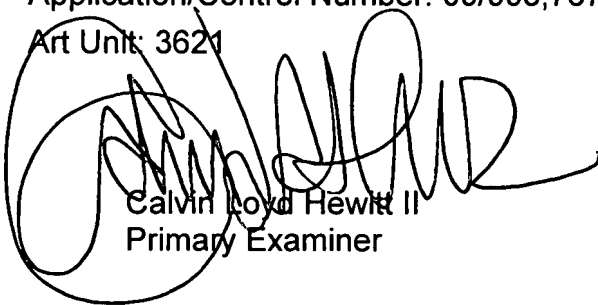
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Application/Control Number: 09/993,767

Page 8

Art Unit: 3621

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Calvin Lloyd Hewitt II  
Primary Examiner

September 10, 2007